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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FULTS, RICHARD C

ART UNIT PAPER NUMBER

3628

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/414,731

Applicant(s)

GANESAN ET AL.

Examiner

Richard Fults

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remington et al (US 6,070,150 A) (hereinafter Remington) in view of Lemay, Teach Yourself Web Publishing With HTML 3.0 in a Week, 1996 (hereinafter Lemay) , and Wall Street \*E Banking, 1/7/1997 (hereinafter Wall).

As to **Claims 1-27** Remington discloses (see at least columns 1-20 and in particular columns 1-8 and 16-17) a central network station to transmit bill availability information regarding billers and users with bill information being available at two different websites (of either a bill aggregator or an individual biller), different user stations configured to receive bill information and to select one of the bills, with each different user linked to a first biller address based on a first bill selection by the different users. Remington's invention is directed primarily at individual billers, and references in column 5 the fact of a billing page from a first biller address including hyperlinks to "target resources, such as Web sites on the internet", which is a second address and could be that of an original biller . Remington also teaches the various methods, steps,

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and computer, processor, memory, and database systems for both bill presentment and payment in different formats, transmitted over the internet from a biller (payee) to multiple consumers, including the same process for an aggregator of such billers, and including the concept of using the presentment process as a vehicle for communicating additional information to the consumer such as billing and sales information and advertisements and hyperlinks to other internet sites, all information being customizable such that "The bill presentment and payment remittance system allows the biller to create a bill and payment remittance information in any desired format the biller chooses", or whatever format the biller decides is appropriate (design choice) to accomplish the bill presentment and payment process, with whatever information data combination for each consumer that may be desired or is compatible with various accounting systems or as deemed as being artistic in nature, including email communications to the consumer relative to his account as deemed appropriate by the biller, and including the computer systems for hyperlinked cross access of bill presentment and payment information. Remington generally describes the capabilities of the internet to cross access information through hyperlinks to sites and databases, but Remington does not fully describe these capabilities. Remington does not specifically teach a second biller address for the same bill.

However, Lemay discloses (see at least pages 4-11 and 114-115) the concept of a hyperlink posted on a page of one address which when clicked will lead a user to a second address, as well as all of the internet capability features contained in claims 1-27, by teaching that the world wide web of the internet: is a hypertext information system, is graphical and easy to navigate, is cross platform, is distributed, is dynamic, can access many forms of internet information, and is interactive, and **that lists of items (bills from an aggregator) contained on a web page can be made to have built-in hyperlinks to other web sites (individual sellers using the aggregation services) embedded in the item title or description.** One example (design choice) of this common and well known hyperlink capability could be a list of payees on a bill aggregator's email to a consumer (or the name of the bill aggregator listed on the website of the payee) showing how much is due to the payee by the consumer, with a

hyperlink embedded in each payee's name so that to communicate with that specific payee all the consumer has to do is to click on the name with a computer mouse and they can either go into an email mode with the screen ready to accept an email message to the original payee which message could include additional hyperlinks, or be directed to the website of the original payee and have access to the consumer's account information in whatever format the payee has deemed as appropriate for that particular consumer (design choice), displaying whatever set of consumer information the payee has decided upon, or by clicking at the payee's site on the name of the bill aggregator to review the information contained there or to communicate with them via email. Another example would be the ability to click on a specific payee's total amount due or a description title in the aggregator's bill presentment that says "more detail" to see as much information as the bill aggregator or original payee is willing to provide, with possibly an additional title besides each payee name that says "pay now" that can be clicked by the consumer.

One very well known example of this common and well known capability in action is the ebay auction system, which contains in its "my ebay" page (first biller address) a list of all wins due for payment to various sellers with both payment and email hyperlinks to the individual sellers (second biller address). In addition, that page also has a hyperlink (by clicking on the name of the item) back to the detailed information of the original auction page that generated the sale to begin with. Other similar examples can be seen all over the internet on websites long in use there.

**Wall** discloses (see pages 1-3) claims 1-27 regarding an aggregator bill presentment system called MyBillCenter that describes how simple their system is to receive, review, and pay bills presented on the internet in different formats, with user customizable features of organizing the bills for payment, which system incorporates the features described in Remington and Lemay and contained in claims 1-27.

Claims 1-27 are rejected under 35 USC 103(a) as obvious over Remington in view of Lemay and Wall. Because it would have made common sense, been beneficial, and provided a more flexible and cost efficient system of bill presentment and payment communications to the consumer, it would have been obvious to one skilled in the art at

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the time of the invention to add the teachings of Lemay and Wall to those of Remington, and to add those of Remington to those of the others for the same reason.

However it would have been obvious to one skilled in the art at the time of the invention to use cross linked hyperlinks to enable the consumer to access information at the sites of both the bill aggregator and the original payee from each other's sites because that would be common sense and beneficial, knowing that a consumer would want to contact the original payee in the event of questions about their bill, as the aggregator would not normally know the details the payee would, and the payee would not normally have the latest status of payment that the aggregator would, and each would have a different set of data from the consumer database to present to each individual consumer at their site.

### **3. Response to Arguments**

As persons of scientific competence in the fields in which they work, examiners and administrative patent judges on the Board are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would provide to such persons. Absent legal error or contrary factual evidence, those findings can establish a prima facie case of obviousness. In this case, the appellants have not pointed to any legal error affecting the Board's obviousness analysis. Nor have they pointed to sufficient factual grounds, either in the record or in any judicially noticeable sources, to question the findings made by the examiner and the Board as to the teachings of the prior art and the motivation that the prior art references would give to a skilled artisan to make the claimed invention. We therefore sustain the Board's conclusion that the recited prior art references established a prima facie case of obviousness with respect to the appealed claims of the '774 and '654 applications.

02-1120, IN RE RICHARD A. BERG, ET AL.

-1160 On appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences.

Decision affirmed.

Opinion by Bryson, Circuit Judge.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, \*\*\*.

In response to applicant's argument that there is nothing within the applied art teachings which would suggest the Examiner's proposed combination to arrive at the invention claimed in the present application, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is the responsibility of the applicant to review all the referenced material regarding their teachings applicable to the application.

The rejections made were applicable to all the claims in the group, because the group consisted of a common bill payment computer system using common hyperlinks to access a second site for the bills, all as taught by the obvious combination of

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references, which taught both aggregator billing sites (first) and individual billing sites (second) and the hyperlinks common to the internet which could easily connect the two by simple design choice. All of the specific limitations claimed were covered by the cited references in combination.

Lemay teaches most of the common attributes and capabilities of the internet and the widespread and common use of hyperlinks, all of which information was well known, readily available, and consequently obvious to one skilled in the art at the time of the invention regarding their standard application in network design for e-commerce, specifically including billing systems. Remington teaches all the standard and newly invented flexible methods and computer processes/methods for individual billers to bill users (and in the specifications on columns 1-3 teaches the prior existence of bill aggregators such as CheckFree, Intuit, VISA, etc), and Wall teaches the most up to date methods/processes for billing as a bill aggregator. Anyone skilled in the art at the time of the invention would be aware of all three cited references and would have easily combined them as a matter of design choice for a billing system that desired to use both the bill aggregator address (first address) and the original biller (seller) address (second address) to view the same bill via hyperlinks in different degrees of detail, which outcome is the essence of this claimed invention.

Regarding bills of a single biller being stored at different addresses with information at one address for one user not included with the bill available to another user at another address, it would be obvious that each user has a different set of bills not available to other users at **any** address. Lemay teaches the use of hyperlinks from one site to another, from a list of items at the first site, and the second site could be a second billing address if one so desired as a design choice, at the site of the original biller (seller). In claim 9 Remington teaches multiple users of the biller and allows for hyperlinks to other addresses, one of which could be a second billing address. Claim 9 does not discuss a third user, but Remington teaches multiple users which as a practical matter for a business of that type would have to number in the thousands. As a matter of common knowledge, CheckFree and Intuit and VISA have users numbering in the tens of thousands. Claim 22 is merely a non-statutory claim of a database



containing data. The first half of claim 23 talks about multiple users with multiple bills available from the first address, which is Remington's system. The second half talks about a second bill for a second user at a second address, which the combination of the three references teaches as being obvious.

#### **4. Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Note is taken by the examiner that should the applicant find objectionable any statements made herein by the examiner regarding inherency, implicitness, obviousness, or Official Notice, Applicant can make a proper challenge to those statements only by providing adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying those statements: a simple response requesting a reference without doing so, or a response that fails to logically refute the basic assumptions underlying the justification, will result in an improper and failed challenge and those unchallenged statements will remain the record of the case. Applicants must seasonably challenge those statements in the first response following an Office Action. If an applicant fails to do so, his right to challenge them is waived.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



RCF

2/27/2003



Primary Examiner